REMARKS

As there was no objection in Paper No. 6 to the proposed drawing correction submitted with the amendment filed on June 3, 2002, Applicant assumes that the proposed drawing correction is approved by the Examiner and that the objection to the drawings and the specification is withdrawn.

Claims 1-7, 13, 17 and 20 have been amended as suggested by the Examiner to overcome the rejections under 35 U.S.C. § 112, second paragraph.

Claims 1-20 remain pending in the application.

Applicant respectfully requests reconsideration and examination of Claims 1-20 in view of the amendments above and the arguments below.

By way of this response, Applicant has made a diligent effort to place the claims in condition for allowance. However, should there remain any outstanding issues that require adverse action, it is respectfully requested that the examiner telephone Thomas F. Lebens at (858)587-7644 so that such issues may be resolved as expeditiously as possible.

Response to the rejection under 35 U.S.C. § 112

Claims 1-20 stand rejected under 35 U.S.C. § 112 as being indefinite. Applicant has amended Claims 1-7, 13, 17 and 20 to delete the term "sufficient" objected to in Claims 7 and 13 by the rejection and to recite that the claimed force constant of the resilient member is selected to produce a displacement of the distal portion of the resilient member so that the paintbrush does not slide off the magnet to overcome the rejection. However, the term "sufficient" is definite according to MPEP § 2173.05(c)(III) (2100-168), which states:

> "The common phrase 'an effective amount' may or may not be indefinite. The proper test is whether or not one

skilled in the art could determine specific values for the amount based on the disclosure. See *In re Mattison*, 509 F.2d 563, 184 USPQ 484 (CCPA 1975). The phrase 'an effective amount ... for growth stimulation' was held to be definite where the amount was not critical and those skilled in the art would be able to determine from the written disclosure, including the examples, what an effective amount is. *In re Halleck*, 422 F.2d 911, 164 USPQ 647 (CCPA 1970)."

The rejection errs in failing to apply the proper test to determine whether or not one skilled in the art could determine what is a sufficient displacement of the distal end of the claimed resilient member based on Applicant's disclosure. In fact, Applicant's disclosure clearly explains how a sufficient displacement is determined beginning on page 5, line 16 and continuing to page 7, line 6 as required by MPEP § 2173.05(c)(III). Because one skilled in the art could determine what a sufficient displacement of the distal end of the claimed resilient member is based on Applicant's disclosure, the term "sufficient" is definite under 35 U.S.C. § 112 according to patent law cited by MPEP § 2173.05(c)(III).

The rejection further errs in apparently confusing combination and subcombination terminology with the functional limitations in Claims 1 and 4, Claims 7 and 13, and Claims 10, 17 and 20. Functional limitations are explained in MPEP § 2173.05(g) as follows:

"A functional limitation is an attempt to define something by what it does, rather than by what it is (e.g., as evidenced by its specific structure or specific ingredients). There is nothing inherently wrong with defining some part of an invention in functional terms. Functional language does

not, in and of itself, render a claim improper. *In re Swinehart*, 439 F.2d 210, 169 USPQ 226 (CCPA 1971).

A functional limitation must be evaluated and considered, just like any other limitation of the claim, for what it fairly conveys to a person of ordinary skill in the pertinent art in the context which it is used. A functional limitation is often used in association with an element, ingredient, or step of a process to define a particular capability or purpose that is served by the recited element, ingredient, or step.

...

It was held that the limitation used to define a radical on a chemical compound as 'incapable of forming a dye with said oxidizing developing agent' although functional, was perfectly acceptable because it set definite boundaries on the patent protection sought. *In re Barr*, 444 F.2d 588, 170 USPQ 33 (CCPA 1971)."

Applicant requests that the functional limitations of "for engaging a rim of a paint can", "for engaging a ferrule of a paintbrush", and "wherein the resilient member has a force constant selected to produce a displacement of the distal portion when the paintbrush is subjected to a mechanical shock so that the paintbrush does not slide off the magnet" be evaluated and considered for what they fairly convey to a person of ordinary skill in the pertinent art in the context which they are used in Claims 1 and 4, Claims 7 and 13, and Claims 10, 17 and 20 to determine patentability under 35 U.S.C. § 103(a) as required by patent law.

Response to the rejections under 35 U.S.C. § 103

Claims 1-10, 13, 15-17 and 20 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over *Craig*. Applicant traverses the rejection as follows.

Regarding the rejection of Claims 1-6, the rejection

errs on page 3 in failing to consider all the limitations recited in the claims. Specifically, Claim 1 recites a clamp 6 for engaging the rim of the paint can as shown in FIG. 1 and described in the specification on page 4, lines 29-30. The rejection fails to consider all the claim limitations and incorrectly concludes that the claimed clamp reads on the spring clip (16) for engaging a fuel line (10) disclosed in *Craig* in column 1, lines 62-65 and FIG. 1. The spring clip (16) disclosed in *Craig* is for engaging a fuel line (10). In contrast to *Craig*, Claims 1-6 require a clamp for engaging a paint can. Because the claimed clamp for engaging a paint can does not necessarily flow from *Craig's* teaching of a spring clip for engaging a fuel line, *Craig* does not teach or suggest the claimed clamp for engaging the rim of a paint can. Because the rejection fails to consider all the claim limitations, the rejection fails to establish *prima facie* obviousness under 35 U.S.C. § 103(a) as required by patent law. Specifically, MPEP § 2143.03 states:

> To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "All words in a claim must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)."

Further, Claims 1-6 recite a magnet 1 shown in FIG. 1 of the subject application for engaging the ferrule of a paintbrush. The rejection errs in failing to consider all the claim limitations and incorrectly concludes that the claimed magnet reads on the magnets (42) and (44) for ionizing fuel molecules in a fuel line as disclosed by *Craig* in column 2, lines 19-41 and shown in FIG. 1. Because the claimed magnet

for engaging the ferrule of a paintbrush does not necessarily flow from the teaching of a magnet for ionizing fuel molecules disclosed in *Craig*, *Craig* does not teach or suggest the claimed magnet for engaging the ferrule of a paintbrush. Again, because the rejection fails to consider all the claim limitations, the rejection fails to establish *prima facie* obviousness under 35 U.S.C. § 103(a) as required by patent law cited by MPEP § 2143.03. Because the rejection fails to establish *prima facie* obviousness under 35 U.S.C. § 103(a), Applicant requests that the rejection of Claims 1-6 under 35 U.S.C. § 103(a) over *Craig* be withdrawn.

The rejection further errs in alleging that the distal portion of the spring (110) shown by *Craig* in FIG. 1 and described in column 3, lines 18-23, is attached to a magnet. As *Craig* explains in lines 18-23, the distal end of the spring (110) is attached to the handle (34) of the spring clip (16), not to a magnet as alleged by the rejection.

The rejection further errs in alleging that *Craig* divulges the structure of a magnet and a clamp oriented as required by the claims. The claims require a clamp for engaging the rim of a paint can. The spring clips (16) and (60) disclosed in Craig do not engage the rim of a paint can. Claims 1-6 require a magnet for engaging the ferrule of a paintbrush. The magnets (42) and (44) disclosed in *Craig* do not engage the ferrule of a paintbrush. Because the structure of the magnets (42) and (44) and the spring clips (16) and (60) disclosed in *Craig* do not meet the requirements of Claims 1-6, *Craig* clearly does not disclose either the claimed magnet or the claimed clamp. Because the rejection fails to establish *prima facie* obviousness under 35 U.S.C. § 103(a), Applicant requests that the rejection of Claims 1-6 under 35 U.S.C. § 103(a) over *Craig* be withdrawn.

Regarding the rejection of Claims 7-9, 13, 15 and

16, the claimed force constant of the resilient member is selected to produce the claimed displacement of the distal portion of the resilient member so that the paintbrush does not slide off the magnet. The rejection errs in failing to consider all the claim limitations and incorrectly concludes that the claimed force constant and the claimed displacement read on any force constant and any displacement inherent in a spring, including the spring (110) disclosed by *Craig* in column 3, lines 18-29 and illustrated in FIG. 1. The claimed force constant selected to produce the claimed displacement of the distal portion of the resilient member so that the paintbrush does not slide off the magnet does not necessarily flow from the teaching of the spring (110) enclosing the magnet (120) in *Craig*, therefore the claimed force constant and the claimed displacement are not inherent in *Craig* as alleged by the rejection. Again, because the rejection fails to consider all the claim limitations, the rejection fails to establish *prima facie* obviousness under 35 U.S.C. § 103(a) as required by patent law cited by MPEP § 2143.03. Because the rejection fails to establish *prima facie* obviousness under 35 U.S.C. § 103(a), Applicant requests that the rejection of Claims 7-9, 13, 15 and 16 under 35 U.S.C. § 103(a) over *Craig* be withdrawn.

Regarding the rejection of Claims 10, 17 and 20, the rejection further errs in relying on hindsight gained from the Applicant's disclosure for motivation to select the force constant of the resilient member to limit the acceleration of the paintbrush to 0.75 g. The rejection fails to show where *Craig* teaches or suggests selecting a force constant to limit the acceleration of a paintbrush to no more than 0.75 g. The motivation cited by the rejection of not compromising the integrity of the paintbrush holder is not found in *Craig*, because *Craig* does not even disclose a paintbrush holder.

Even if *Craig* did disclose a paintbrush holder, the rejection fails to explain how the objective of not compromising the integrity of the paintbrush holder would lead one of ordinary skill in the art in view of *Craig* to arrive at the claimed limiting the acceleration of a paintbrush to no more than 0.75 g so that the paintbrush does not slide off the magnet. Because no motivation is shown in *Craig* to make the modification proposed by the rejection, and because the proposed modification clearly relies on hindsight gained from Applicant's disclosure, Applicant requests that the rejection of Claims 10, 17 and 20 under 35 U.S.C. § 103(a) over *Craig* be withdrawn.

Claims 7, 9-14 and 16-20 stand finally rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,729,158 to Nagy (*Nagy*). Applicant traverses the rejection as follows.

Regarding the rejection of Claims 7, 9, 11-14, 16, 18 and 19, the rejection errs in alleging that *Nagy* discloses the claimed resilient member having a force constant selected to produce a displacement of the distal portion when the paintbrush is subjected to a mechanical shock so that the paintbrush does not slide off the magnet. In FIG. 1 and column 2, lines 36-44, *Nagy* discloses an attachment (20) made of a length of flat-faced strap metal. There is no teaching or suggestion in *Nagy* that the flat-faced strap metal has a force constant selected to produce a displacement of the distal portion when the paintbrush is subjected to a mechanical shock so that the paintbrush does not slide off the magnet as required by Claims 7, 9, 11-14, 16, 18 and 19. The rejection clearly errs in failing to consider all the limitations recited in the claims. Specifically, Claims 7, 9, 11-14, 16, 18 and 19 recite that the claimed force constant of

the resilient member is selected to produce the claimed displacement of the distal end of the resilient member so that the paintbrush does not slide off the magnet. The rejection errs in failing to consider all the claim limitations and incorrectly concludes that the claimed force constant and the claimed displacement are inherent in the flat-faced strap metal disclosed in *Nagy*. The claimed force constant selected to produce a displacement of the distal end when the paintbrush is subjected to a mechanical shock so that the paintbrush does not slide off the magnet is not disclosed in *Nagy*. Moreover, the claimed force constant selected to produce a displacement of the distal end when the paintbrush is subjected to a mechanical shock so that the paintbrush does not slide off the magnet does not necessarily flow from the teaching of a flat-faced metal strap, therefore the claimed force constant selected to produce a displacement of the distal end when the paintbrush is subjected to a mechanical shock so that the paintbrush does not slide off the magnet is not inherent in *Nagy* as alleged by the rejection. Again, because the rejection fails to consider all the claim limitations, the rejection fails to establish *prima facie* obviousness under 35 U.S.C. § 103(a) as required by patent law cited by MPEP § 2143.03. Because the rejection fails to establish *prima facie* obviousness under 35 U.S.C. § 103(a), Applicant requests that the rejection of Claims 7, 9, 11-14, 16, 18 and 19 under 35 U.S.C. § 103(a) over *Nagy* be withdrawn.

The rejection further errs in alleging that *Nagy* discloses the claimed paintbrush holder of Claim 14 wherein the resilient member, the magnet holder, and at least a portion of the clamp constitute a single molded structure. As *Nagy* explains in column 2, lines 60-67 and column 3, lines 1-5, the magnet (48) is held on the upper portion of the leg (24) by a washer (40) and two rectangular cleats (42) and

(44). Because the structure of the magnet holder disclosed in *Nagy* includes the washer (40) and two separate rectangular cleats (42) and (44) that are fastened to the vertical leg (24) to make the magnet holder, the magnet holder disclosed in *Nagy* clearly does not constitute a single molded structure as alleged by the rejection. The rejection therefore errs in reading the limitation of "a single molded structure" recited in Claim 14 into *Nagy* even though *Nagy* clearly does not teach a resilient member, a magnet holder, and at least a portion of a clamp constituting a single molded structure.

Regarding the rejection of Claims 10, 17 and 20, the rejection further errs in relying on hindsight gained from the Applicant's disclosure for motivation to select the force constant of the resilient member to limit the acceleration of the paintbrush to 0.75 g. The rejection fails to show where *Nagy* teaches or suggests selecting a force constant to limit the acceleration of a paintbrush to no more than 0.75 g. The motivation cited by the rejection of not compromising the integrity of the paintbrush holder is not found in *Nagy*. Even if it were, the rejection fails to explain how the objective of not compromising the integrity of the paintbrush holder would lead one of ordinary skill in the art in view of *Nagy* to arrive at the claimed limiting the acceleration of a paintbrush to no more than 0.75 g so that the paintbrush does not slide off the magnet. Because no motivation is shown in *Nagy* to make the modification proposed by the rejection, and because the modification proposed by the rejection relies on hindsight gained from Applicant's disclosure, Applicant requests that the rejection of Claims 10, 17 and 20 under 35 U.S.C. § 103(a) over *Nagy* be withdrawn.

Conclusion

Because all the words in the functional claim limitations of "for engaging a rim of a paint can", "for

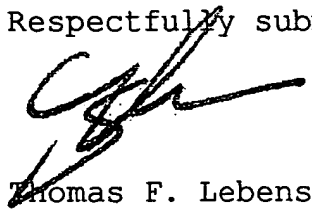
engaging a ferrule of a paintbrush", and "wherein the resilient member has a force constant selected to produce a displacement of the distal portion when the paintbrush is subjected to a mechanical shock so that the paintbrush does not slide off the magnet" were not considered in determining patentability under 35 U.S.C. § 103(a) as required by patent law, and because the functional limitations are proper according to patent law, and because the rejection reads limitations from Applicant's disclosure into the cited references that are not present in the references, and because the combination of references cited by the rejection fails to arrive at the claimed invention, and because the rejection relies on hindsight gained from Applicant's disclosure to find motivation for the proposed modification, the rejection fails to establish *prima facie* obviousness under 35 U.S.C. § 103(a). Because the rejection fails to establish *prima facie* obviousness under 35 U.S.C. § 103(a), Applicant requests that the rejection of Claims 1-20 under 35 U.S.C. § 103(a) over *Craig* be withdrawn.

A version with markings to show changes begins on the following page.

No additional fee is required for this amendment.

In view of the above amendments, Applicant submits that Claims 1-20 are in condition for allowance, and prompt and favorable action is earnestly solicited.

Respectfully submitted,



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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Claims:

The following like-numbered claims have been amended:

1.(twice amended) A paintbrush [~~holder, attachable to a paint can having an open end defined by a rim, for supporting a paintbrush having a ferrule within the open end of the paint can, the~~] holder comprising:

a clamp for engaging a [~~the~~] rim of a [~~the~~] paint can;

a magnet for engaging a [~~the~~] ferrule of a [~~the~~] paintbrush; and

a resilient member having a proximal portion attached to the clamp and having a distal portion attached to the magnet wherein [~~the distal portion of~~] the resilient member has a force constant selected to produce a displacement of the distal portion [~~is displaced~~] when the paintbrush is subjected to a mechanical shock so that the paintbrush does not slide off the magnet.

2.(twice amended) The paintbrush holder [~~improvement~~] of Claim 1 wherein the resilient member is a spring.

3.(twice amended) The paintbrush holder [~~improvement~~] of Claim 1 wherein the resilient member is a length of resilient material.

4.(twice amended) A [~~In a magnetic~~] paintbrush holder [~~of a type having a clamp for fastening the holder to the rim of a paint can and having a magnet connected to the~~

~~clamp for magnetically engaging the ferrule of a paintbrush, an improvement~~] comprising:

a resilient member having a proximal portion attached to a [~~the~~] clamp for engaging the rim of a paint can and a distal portion attached to a [~~the~~] magnet for engaging a ferrule of a paintbrush wherein [~~the distal portion of~~] the resilient member has a force constant selected to produce a displacement of the distal portion [~~is displaced~~] when the paintbrush is subjected to a mechanical shock so that the paintbrush does not slide off the magnet.

5.(twice amended) The paintbrush holder [~~improvement~~] of Claim 4 wherein the resilient member is a spring.

6.(twice amended) The paintbrush holder [~~improvement~~] of Claim 4 wherein the resilient member is a length of resilient material.

7.(amended) A paintbrush holder comprising:

a magnet for engaging the ferrule of a paintbrush;

a clamp for engaging a rim of a paint can; and

a resilient member having a proximal end attached to the clamp and a distal end attached to the magnet wherein the resilient member has a force constant selected to produce a [~~sufficient~~] displacement of the distal end when the paintbrush is subjected to a mechanical shock so that the paintbrush does not slide off the magnet.

13.(amended) A paintbrush holder comprising:

a magnet for engaging the ferrule of a paintbrush;

a magnet holder for bonding to the magnet;

a clamp for engaging a rim of a paint can; and

a resilient member having a proximal end attached to the clamp and a distal end attached to the magnet holder wherein

the resilient member has a force constant selected to produce a [~~sufficient~~] displacement of the distal end when the paintbrush is subjected to a mechanical shock so that the paintbrush does not slide off the magnet.

17.(amended) The paintbrush holder of Claim 13 wherein the force constant of the resilient member is selected to limit [~~limits~~] acceleration of the paintbrush to no more than 0.75 g.

20.(amended) The paintbrush holder of Claim 1 wherein the force constant of the resilient member is selected to limit [~~limits~~] acceleration of the paintbrush to no more than 0.75 g.